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EXAMINER
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LERNER, MARTIN

ART UNIT	PAPER NUMBER
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2626

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12/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/626,050

Applicant(s)

DAVIS ET AL.

Examiner

Martin Lerner

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 to 6, 8, 10 to 11, and 13 to 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 6, 8, 10 to 11, and 13 to 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 to 6, 8, 10 to 11, and 13 to 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 8, and 18 contain the limitations of "a PSTN-based teleconferencing system" and "a PSTN teleconferencing subsystem", which limitations represent new matter. Applicants' originally-filed Specification does not disclose "a PSTN teleconferencing system". The best that Applicants' originally-filed Specification can reasonably be said to disclose is a teleconferencing system 24 and a PSTN 16 at ¶[0014] and Figure 1. However, there is no disclosure of "a PSTN teleconferencing system" because there is nothing that says the teleconferencing system has any characteristics making it suited for receiving data only from a PSTN. Moreover, Applicants' originally-filed Specification discloses a conventional telephone 26, 28 and a PSTN 16, but not a "PSTN telephone call" or "a PSTN-based telephone". Nor does the Specification disclose "a data network port", "a PSTN network input port" or "receiving calls from a calling party's PSTN telephone".

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 to 6, 8, 10 to 11, and 13 to 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 8, and 18 contain the limitation that the teleconferencing system and the messaging system are "directly coupled" by the speech processing system, which limitation is indefinite. It is unclear to what extent any two elements are "directly coupled" in a communications system because there are always additional elements present that provide the coupling. Applicants, it is appreciated, are attempting to amend the claims in a manner to distinguish over *Moore et al.* ('041). However, Applicants' Figure 1 even shows that the teleconferencing system and the messaging system are not "directly coupled" by the speech processing system because there is at least a data network between the teleconferencing system, the instant messaging system, and the text-to-speech/speech-to-text processing system. Moreover, there could be any arbitrary number of additional element further present within data network 17. Data networks commonly contain servers, routers, *etc.*, so saying that the elements are "directly coupled" is misdescriptive and arbitrary. Thus, Applicants' limitation that the elements are "directly coupled" is vague and indefinite due the presence of further elements, and is misdescriptive of Applicants' own disclosure and figures.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 to 6, 8, 10 to 11, and 13 to 19 are rejected under 35 U.S.C. 102(e) as being anticipated by *Moore et al.* ('041).

Regarding independent claims 1 and 18, *Moore et al.* ('041) discloses a method and machine readable program code for responding to messages, comprising:

“receiving a PSTN telephone call at a PSTN-based teleconferencing system from a PSTN-based telephone, wherein said teleconferencing system is communicatively linked to an instant messaging system managing the conference, wherein said teleconferencing system and said messaging system are directly coupled by a speech processing system” – speech information from a user using a telephone 62 (“a PSTN-based telephone”) is carried through PSTN 60 and arrives as a conventional telephone signal at VoIP gateway 54 (Page 10: ¶[0105]; Figure 1); gateway system 50 includes intelligent chat gateway 52 and voice-over-Internet Protocol (VoIP) gateway 54 (Page 8, ¶[0093]; Figure 1); intelligent chat gateway 52 manages messaging communications among a plurality of parties (Page 2: ¶[0030], Page 8: ¶[0096]); managing

communication among a plurality of parties is equivalent to “a teleconferencing system”, and because intelligent chat gateway 52 manages communication among parties including calls from telephone 62 via PSTN 60, it is “a PSTN-based teleconferencing system”; moreover, service provider system 30 may include, without limitation, conference call establishment (Page 7: ¶[0087]); intelligent chat gateway 52 of gateway 50 (“said teleconferencing system”) is “directly coupled” to instant messaging (IM) server 22 through connection 86, and is “directly coupled” to intelligent media translator 70 providing a text-to-speech 72 and speech-to-text 74 processing system (“a speech processing system”) through connections 75, 78, 80 (Page 10: ¶[0103]: Figure 1);

“receiving at said speech processing system a speech input received by said PSTN teleconferencing system” – speech information from a caller using telephone 62 is carried through PSTN 60, and is directed to speech-to-text module 74 at gateway system 50 (Page 10, ¶[0105]: Figure 1); gateway system 50 includes intelligent chat gateway 52 (“said PSTN teleconferencing system”) (Page 8, ¶[0093]: Figure 1);

“transcribing the speech into a first text message using said speech processing system” – the packetized data stream is directed to speech-to-text module 74 (“said speech processing system”) to convert the received speech signals into a textual representation (Page 10: ¶[0105]: Figure 1);

“transmitting the first text message to a plurality of devices participating in the instant messaging based conference” – the textual information may then be sent to a text chat interface of chat client 14, perhaps in the form of a typical chat message, via network 20 and perhaps involving IM service 22; an optional instant messaging sender

79a is depicted along connection 76 representing adaptation of the speech-to-text module 74 to carry on instant communications with chat client 14 (Page 10: ¶[0105]: Figure 1); a chat client 14 supports communications with one or more principals, and instant messaging through which text messages can be exchanged in real time with one or more other parties (“to a plurality of devices participating in the instant messaging based conference”) (Page 6: ¶[0075], Page 7: ¶[0082]);

“receiving at said speech processing system a second text message from any one among the plurality of devices participating in the instant messaging based conference” – intelligent media translator (IMT) 70 may comprise a port for receiving textual information from a messaging client (Page 10: ¶[0104]: Figure 1); chat client 14 may be implemented by or based upon well known instant messaging (Page 6, ¶[0075]: Figure 1);

“converting the second text message to a speech output” – intelligent media translator 70 comprises a text-to-speech conversion process for converting the received textual information into corresponding speech signals via a text-to-speech module 72 (Page 10: ¶[0103] - ¶[0104]: Figure 1);

“transmitting the speech output to the telephone via the PSTN-based teleconferencing system” – speech signals are sent through a communications medium, such as a telephone connection or RTP session, to a chat client 14 or telephone 62 (Page 10: ¶[0103] - ¶[0104]: Figure 1); telephone 62 is connected through PSTN 60, so any speech output to telephone 62 must be through PSTN 60 from gateway system 50 (“the PSTN-based teleconferencing system”).

Regarding independent claim 8, *Moore et al.* ('041) discloses a messaging response system, comprising:

“an instant messaging subsystem having a data network port for managing a plurality of instant messaging devices participating in said conference” – instant messaging (IM) service 22 communicates instant messages through chat client 14 (“a data network port”) so that text instant messages can be exchanged in real time with one or more parties (Page 7, ¶[0077]- ¶[0082]: Figure 1);

“a PSTN teleconferencing subsystem, having a PSTN network input port for receiving calls from a calling party's PSTN telephone” – speech information from a user using a telephone 62 (“a PSTN-based telephone”) is carried through PSTN 60 and arrives as a conventional telephone signal at VoIP gateway 54 (Page 10: ¶[0105]: Figure 1); intelligent chat gateway 52 manages messaging communications among a plurality of parties (Page 2: ¶[0030], Page 8: ¶[0096]); managing communication among a plurality of parties is equivalent to “a teleconferencing system”, and because intelligent chat gateway 52 manages communication among parties including calls from PSTN telephone 62, it is “a PSTN-based teleconferencing system”;

“a speech processing subsystem directly coupling said messaging and said teleconferencing subsystems, wherein said speech processing subsystem comprises:” – intelligent media translator (IMT) 70 may comprise a port for receiving speech signals from a chat client 14 or from telephones 62 (Page 10: ¶[0104] - ¶[0105]: Figure 1); intelligent chat gateway 52 manages messaging communications among a plurality of



parties (Page 2: ¶[0030], Page 8: ¶[0096]); thus, managing communication among a plurality of parties is equivalent to “a teleconferencing system”; moreover, service provider system 30 may include, without limitation, conference call establishment (Page 7: ¶[0087]);

“a speech-to-text converter for converting a calling party’s speech input to a text message for transmission to said participating devices using said an instant messaging subsystem” – speech-to-text module 74 converts between speech signals received from telephones such as telephone 62 and text chat employed by chat client 14 (Page 10: ¶[0104]: Figure 1); chat client 14 may be implemented by or based upon well known instant messaging (Page 6, ¶[0075]: Figure 1);

“a text-to-speech converter for converting text messages received from any one among the participating devices to a speech output for transmission to said PSTN telephone using the PSTN teleconferencing subsystem” – text-to-speech module 72 converts between text chat employed by chat client 14 by speech synthesis to provide speech signals for telephones such as telephone 62 (Page 10: ¶[0104]: Figure 1).

Regarding claims 2, 13, and 17, *Moore et al. ('041)* discloses a profile is maintained for a given user (“a user profile”) as a preference as to how synthesized speech presented to him is rendered (“a simulated voice print of the user”); aspects of speech rendering include whether a male or female voice is preferred, approximate speaker age, vocal characteristics, inflection, and local dialect; in some implementations, a party may elect to use a speech persona that is whimsical or that

emulates the characteristics of a popular recognizable personality (" at least one of . . . customized speech output . . . as defined by the user").

Regarding claims 3 and 12, *Moore et al. ('041)* discloses text is converted to speech by text-to-speech module 72 employing speech synthesis technology. (Page 10: ¶[0103]; Figure 1)

Regarding claims 4, 5, 11, and 19, *Moore et al. ('041)* discloses that in the course of converting speech and other audible signals into corresponding symbols or text, IMT 70 may also perform translation among different spoken and written languages, for example, converting English text to Spanish speech and vice-versa; language preferences or compatibilities of one or both of the parties may be known or maintained in a profile database or expressed by devices ("is specified by a profile associated with said identified user"); implicitly, a user is identified in order to be associated with a profile ("identifying a user associated with said PSTN telephone"). (Page 11: ¶[0112])

Regarding claim 6, *Moore et al. ('041)* discloses that, after the packetized data stream is converted into a textual representation by speech-to-text module 74, the textual information is then sent via network 20 ("transmitting a text stream"). (Page 10: ¶[0105]; Figure 1)

Regarding claim 10, *Moore et al. ('041)* discloses that a data processing system 12 may comprise a laptop or handheld computer system, a personal digital assistant (PDA), or a mobile telephone to execute chat client 14 as an application, and to provide chat-based services. (Page 6: ¶[0074]; Figure 1)

Regarding claim 14, *Moore et al. ('041)* discloses that chat client 14 may present a user interface that is within a display device of data processing system 12; chat client 14 has an instant messaging window through which text messages are presented, as well as images and video. (Page 7 ¶[0079]: Figure 2, Page 7: ¶[0082]: Figure 1)

Regarding claim 15, *Moore et al. ('041)* discloses that text messages are exchanged in real time. (Page 7: ¶[0082]: Figure 1)

Regarding claim 16, *Moore et al. ('041)* discloses instant communications by establishing sessions through a network by a TCP/IP connection (Page 5: ¶[0061] - ¶[0062]); a TCP/IP connection involves "data transmission protocols" for communications over the Internet.

### ***Response to Arguments***

7. Applicants' arguments filed 16 October 2007 have been fully considered but they are not persuasive.

Applicants argue that *Moore et al. ('041)* fails to disclose or suggest a system in which PSTN telephones can directly teleconference into an instant messaging conference. Applicants admit that *Moore et al. ('041)* makes numerous references to a chat client making "calls" to users on PSTN-based telephones, but contend that nowhere does *Moore et al. ('041)* describe a mechanism whereby the reverse can occur. Applicants say that *Moore et al. ('041)* fails to provide a mechanism where a PSTN telephone would initiate a connection to a chat client. Furthermore, Applicants state that *Moore et al. ('041)* describes that a VoIP call can be established to a chat

client, but the claims recite no such limitation, but only a PSTN telephone can initiate a call to a teleconferencing system. Finally, Applicants argue that *Moore et al. ('041)* fails to disclose a PSTN-based teleconferencing system and an instant messaging system that are "directly coupled" via a speech processing system. These arguments are not persuasive.

Firstly, *Moore et al. ('041)* clearly contemplates many alternative ways that a party may connect to an instant messaging chat session, thereby enabling communication among users of an instant communications client embodied as a personal digital assistant (PDA), mobile phone or other portable device (Page 6, ¶[0072]: Figure 1). If a user of a chat client 14 desires to establish or join a chat room, the user selects a chat button, if a user is situated at a computer terminal. (Page 7, ¶[0083]: Figure 2) However, *Moore et al. ('041)* clearly discloses that a user may join a chat session, as well, via a telephone 62. One having ordinary skill in the art would understand that a user of a conventional telephone could ordinarily call in for a purpose of establishing a chat session, implicitly. One having ordinary skill in the art, looking at the prior art as a whole, would understand that telephone 62 could join a chat session through instant messaging (IM) service 22 by simply making a telephone call.

Secondly, it is noted that independent claims 1, 8, and 18, as amended, present new issues under 35 U.S.C. §112, 1<sup>st</sup> and 2<sup>nd</sup> ¶'s. Applicants' originally-filed Specification only discloses a conventional phone 26 or 28, a PSTN 16, and a teleconferencing system 24. However, Applicants have amended their claims in a manner that goes substantially beyond their originally-filed Specification. Specifically,

there is no disclosure of "a PSTN-based teleconferencing system". The teleconferencing system is not in any way limited to having characteristics applicable to a PSTN. Thus, "a PSTN-based teleconferencing system" represents new matter. Moreover, there is no disclosure of "a PSTN telephone" or "a PSTN telephone call", only a conventional telephone. Furthermore, the limitation of "directly coupling" is indefinite and misdescriptive because Applicants' own Figure 1, in fact, discloses a data network 17 intermediate between teleconferencing system 24, instant messaging system 22, and speech processing system 12. Additionally, a data network could comprise any number of supplemental elements that would preclude an apt description of being "directly coupled".

Thirdly, the fact that *Moore et al.* ('041) may additionally disclose a VoIP gateway 54 is immaterial. *Moore et al.* ('041) is clearly concerned with providing a plurality of alternative ways that a user may connect to a chat session. A user can connect through a computer terminal, through a PSTN, or through a VoIP gateway. The fact that *Moore et al.* ('041) discloses an additional element of VoIP cannot be said to imply that the reference fails to anticipate the claimed element of a connection through a PSTN.

Therefore, the rejections of claims 1 to 6, 8, 10 to 11, and 13 to 19 under 35 U.S.C. §112, 1<sup>st</sup> ¶, as failing to comply with the written description requirement, of claims 1 to 6, 8, 10 to 11, and 13 to 19 under 35 U.S.C. §112, 2<sup>nd</sup> ¶, as being indefinite, and of claims 1 to 6, 8, 10 to 11, and 13 to 19 under 35 U.S.C. §102(e) as being anticipated by *Moore et al.* ('041), are proper.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Lerner whose telephone number is (571) 272-7608. The examiner can normally be reached on 8:30 AM to 6:00 PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Hudspeth can be reached on (571) 272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

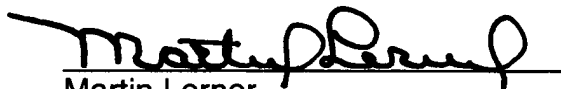
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ML  
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Martin Lerner  
Examiner  
Group Art Unit 2626